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Remarks

Claims 1-2 and 4-14 are currently pending in the patent application. For the reasons and arguments set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The instant Office Action dated May 16, 2007 listed the following rejections: claim 2 stands rejected under 35 U.S.C. § 112(1) as failing to comply with the enablement requirement; claim 2 is rejected under 35 U.S.C. § 112 (2) as being indefinite for failing to particularly point out andt distinctly claim the subject matter which applicant regards as the invention; claims 1 and 10 stand rejected under 35 U.S.C. §102(e) over Smith *et al.* (U.S. Patent Pub. No. 2003/0079150); claims 1 and 10 stand rejected under 35 U.S.C. §102(e) over Huang *et al.* (U.S. Patent Pub. No. 2004/0068684); claims 3, 7-8, and 11 stand rejected under 35 U.S.C. §103(a) over Smith as applied to claim 1 above, and further in view of Durham *et al.* (U.S. Patent No. 5,737,614). Claims 4-6 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In view of the allowability of claims 4-6 and 9, Applicant has rewritten claim 4 in independent form as claim 13, which includes limitations of claims 1, 3 and 4 believed to be the basis for the allowability of claim 4. New claim 14 depends from claim 13 and contains limitations corresponding to those present in claim 5. Applicant submits that (as is consistent with the instant Office Action) new claims 13 and 14 are in condition for allowance. Applicant has also added new claim 12, which depends from claim 10.

Applicant respectfully traverses the Section 112(1) rejection of claim 2 because the claim limitations directed to adding respective delays to a clock signal are enabled by Applicant's Specification. For example, Figure 1 shows delay elements (107 and 109) that delay periodic clock signal 111 (*i.e.*, respective delays are added to the clock signal). *See, e.g.*, Paragraph 0028. Thus, the Section 112(1) rejection of claim 2 is improper and Applicant requests that it be withdrawn.

Applicant respectfully traverses the Section 112(2) rejection of claim 2 because the claim limitations directed to the frequency of the clock generator being low enough to

ensure data integrity during processing of the data elements are defined by Applicant's Specification and thus would be clear to one of skill in the art. Accordingly to M.P.E.P. § 2173.05(b) "(w)hen a term of degree is presented in a claim, first a determination is to be made as to whether the specification provides some standard for measuring that degree." "Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification." *See* M.P.E.P. § 2173.05(b). Applicant's Specification (*e.g.*, Page 3, Col. 2:6-22) clearly provides a standard for determining the frequency of the clock generator such that it is low enough to ensure data integrity. As such, the claim limitations would be clear to one of skill in the art. Therefore, the Section 112(2) rejection of claim 2 is improper and Applicant requests that it be withdrawn.

Applicant respectfully submits that the Section 102(e) rejection of claims 1 and 10 based upon the Smith reference cannot stand. Applicant notes that claims 1 and 10 have been amended to incorporate limitations of claims 3 and 11 respectively, which were acknowledged by the Office Action as not being taught by the Smith reference. *See, e.g.*, page 6 of the instant Office Action. As such, Applicant will address the impropriety of the Section 103(a) rejection of claims 3 and 11.

Applicant respectfully traverses the Section 103(a) rejection of claims 3, 7-8 and 11 because there is no motivation to combine the cited portions of the Smith and Durham references as proposed by the Office Action. According to M.P.E.P. § 2143.01, if the "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). The cited portions of the Smith reference are directed to an instruction based data processing system that operates using a clock signal (*see, e.g.*, Figures 3 and 8; Paragraphs 0023 and 0046), whereas the cited portions of the Durham reference are directed to self-timed or asynchronous systems that transfer data through pipeline stages by controlling the frequency with which data is transferred from one stage to the next (*see, e.g.*, Col. 2:10-25). Applicant submits that Smith's logic units 702-708 are not equivalent to Durham's pipeline stages (10, 20, 30 and 40) and that one of skill in the art would recognize that you can not simply combine the self-timed aspects taught by Durham (*i.e.*, which operate

without a clock signal using handshaking) into the clock based system of Smith. The teachings of the two references appear to be incompatible with each other and, as such, the proposed combination would cause the Smith reference to function in an unpredictable manner thus defeating its purpose. Accordingly, there is no motivation to modify Smith with the cited teachings of Durham. Therefore, the Section 103(a) rejection of claims 3, 7-8 and 11 is improper and Applicant requests that it be withdrawn.

Applicant respectfully submits that the Section 102(e) rejection of claims 1 and 10 based upon the Huang reference cannot stand because the cited portions of Huang do not correspond to claim limitations directed to, in a second mode, the storage elements loading their data elements at a second set of points in time that are essentially identical. The cited portions of Huang teach that BIST controllers 122a-122c are driven by clock signals and the controllers produce the required control signals to test RAMs 110a-110c. The clock signal TCLK is delayed by delay units (130a and 103b), which means that clock signal TCLK is received by controller 122a, then clock signal TCLK1 is received by controller 122b, and after that clock signal TCLK2 is received by controller 122c. *See, e.g.*, Figure 1 and Paragraph 0017. Thus, the Huang reference teaches that the testing of each of RAMs 110a-110c is begun at different points in time as shown in Figure 2. As such, the rejections cannot stand because there is no correspondence to loading data according a second set of points in time that are essentially identical. Accordingly, Applicant requests that the Section 102(c) rejection of claims 1 and 10 be withdrawn.

Applicant notes that Claim 2 is identified in Paragraph 15 on page 5 of the instant Office Action as possibly being rejected under Section 102(e) based upon the Huang reference; however, the discussion includes references to features being inherent to "Endo." Applicant has assumed that the Office Action meant to refer to the Huang reference instead of an "Endo" reference. Should the Examiner in fact be referring to another reference, Applicant requests clarification. Notwithstanding, Applicant submits that any rejection of claim 2 (which depends from claim 1) based upon Huang is improper due to the lack of correspondence between the cited portions of Huang and claim 1 as discussed above.

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In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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